Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MICHAEL YANG and PATRICK BOURGHELLE

Appeal No. 2001-1692
Application No. 09/116,338

HEARD : May 8, 2002

Before GARRIS, JEFFREY T. SMITH and MOORE, ***Administrative Patent Judges***.

JEFFREY T. SMITH, ***Administrative Patent Judge.***

DECISION ON APPEAL

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1 to 8, all of the claims present in the application. We have jurisdiction under 35 U.S.C. § 134.

BACKGROUND

Appellants' invention relates to a method of manufacturing optical ribbons. An optical ribbon is composed of a plurality of optical fibers, that have been grouped together coated and set to form an optical fiber ribbon. The claimed method is directed to producing a plurality of optical fiber ribbons. Claim 1, which is representative of the claimed invention, appears below:

> 1. A method of manufacturing optical fiber ribbons, comprising the steps of:
>
> paying out a plurality of optical fibers using a plurality of optical fiber pay-out units,
>
> grouping said optical fibers together into individual parallel groups prior to entering into a nozzle, wherein a plurality of said groups of optical fibers are fed in parallel into as many nozzles, such that said groups have separate nozzles,
>
> coating said groups of optical fibers in said nozzle with a coating material in order to from [sic, form] a plurality of ribbons of optical fibers,
>
> setting said groups of coated optical fibers simultaneously using a single setting means, in order to form said optical fiber ribbons.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Tokuda et al. (Tokuda)	4,720,165	Jan. 19, 1988
Tanaka et al. (Tanaka)	5,536,528	Jul. 16, 1996

Overton et al. (Overton)	4,913,859	Apr. 3, 1990
Petisce	5,037,763	Aug. 6, 1991
Bonicel et al. (Bonicel)	5,763,003	Jun. 9, 1998

The Examiner entered the following rejections of claims 1 to 8 in the Final Rejection: Claims 1 to 4, 7 and 8 are rejected as unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Tokuda and Tanaka. Claims 1 to 4 are rejected as unpatentable under 35 U.S.C. § 103(a) as obvious over Bonicel. Claim 5 is rejected as unpatentable under 35 U.S.C. § 103(a) as obvious over either Tanaka or Tokuda in combination with Overton. Claim 6 is rejected as unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Tokuda, Tanaka and Petisce. (Final Rejection, pp. 3 and 4.)

Appellants have indicated that the claims 1 to 8 stand or fall together. (Brief, page 5). Accordingly, we select claim 1, the sole independent claim, from the group of rejected claims and decide this appeal as to the Examiner's grounds of rejection on the basis of this claim alone.[1] ***In re Nielson,*** 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); ***Ex parte Ohsumi,*** 21 USPQ2d 1020, 1023 (Bd. of Pat. Appls. and Int. 1991); 37 CFR § 1.192(c)(7)(1997). Thus, the issues on appeal are (1) whether claim 1 is unpatentable under

[1] The Examiner has limited his discussion to claim 1 based upon the Appellants' statement in the Brief. (Answer, p. 3.)

35 U.S.C. § 103(a) as obvious over the combination of Tokuda and Tanaka; and (2) whether claim 1 is unpatentable under 35 U.S.C. § 103(a) as obvious over Bonicel.

DISCUSSION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellants in support of their respective positions. This review leads us to conclude that the Examiner's § 103 rejections are not well founded.

According to the Examiner, Tokuda teaches paying out a plurality of optical fibers, grouping said optical fibers together in a parallel group. The group of optical fibers are fed into a nozzle and coated to form an optical fiber ribbon. A plurality of ribbons of optical fibers are formed downstream from the nozzle by the use of dividing pins and these plurality of ribbons are set simultaneously using a single setting means. The Examiner acknowledges that Tokuda teaches the use of a single coating nozzle however, the Examiner asserts a person of ordinary skill in the art would to have been motivated to used an alternate coating means to avoid tearing of the ribbons down stream from the coating nozzle. Thus, the Examiner asserts a person of ordinary skill in the art would have looked to Tanaka to provide an alternative coating means. The Examiner asserts the use of a separate nozzle for each ribbon, as

disclosed in Tanaka, would have avoided tearing the ribbon. (Answer, pp. 3 and 4.) We consider this position by the Examiner to be deficient.

We do not believe the combined teachings of Tokuda and Tanaka would have produced the claimed invention. In essence, the Examiner is suggesting to use the plurality optical fibers produced in Tokuda as the source for the multiple supply devices (12) of Tanaka. It is true that Tanaka discloses the uses of a plurality of supply devices however, these devices contain preformed tape-shaped coated optical fibers, i.e., an optical fiber ribbon. (Col. 3, ll. 29 to 38.) However, the Examiner has asserted that the system of Tanaka replaces the coating nozzle of Tokuda. Thus, it is our opinion that the combined teachings of Tokuda and Tanaka does not produce the claimed invention. The Examiner has not indicated that the powder application device (13) of Tanaka is suitable for binding together a plurality of optical fibers. Moreover, Tanaka does not disclose the ribbons exiting the powder application device are set simultaneously using a single means, in order to form optical fiber ribbons. On the record before us, it appears the Examiner has reached this conclusion base upon impermissible hindsight derived from Appellants' own disclosure rather than some teaching, suggestion or incentive derived from Tokuda and Tanaka.

The Examiner also rejected the subject matter of claim 1 over Bonicel. According to the Examiner, Bonicel teaches paying out a plurality of optical fibers, grouping said optical fibers together in a parallel group. The group of optical fibers are fed into a nozzle and coated

to form an optical fiber ribbon. The Examiner acknowledges that Bonicel does not teach simultaneously coating a plurality of ribbons. However, the Examiner concludes that it would have been obvious to have provided a plurality of pay-out units, a plurality of groups of ribbons, and a nozzle for each group of ribbons. The Examiner cites ***In re Harza,*** 274 F2d 669, 671, 124 USPQ 378, 380 (CCPA 1960), for the premise that duplication of parts has no patentable significance. We consider this position by the Examiner to be deficient for several reasons.

First, the Examiner appears to be applying a *per se* rule that the duplication of parts has no patentable significance. As stated by the court in ***In re Ochiai,*** 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995):

> The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention - including all its limitations - with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease.

The Examiner has not carried out the required fact specific analysis. That is, the Examiner has not explained why Bonicel shows that one of ordinary skill in the art would have been led to duplicate portions of Bonicel to make fiber optic ribbons by the method recited in the Appellants' claimed invention, and would have had a reasonable expectation of success in

doing so. ***See In re O'Farrell,*** 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). Moreover, the Examiner's reliance on ***In re Harza*** is inappropriate on this record because he has not established that the basic structure of the claimed invention is not patentably distinguishable from that taught by Bonicel. ***See Harza,*** F2d 671, USPQ 380. ("The only distinction to be found is in the recitation in claim 1 of a plurality of ribs on each side of the web whereas Gardner [cited prior art] shows only a single rib on each side of the web.") In the present case, there are numerous differences in the structure of Bonicel and the claimed invention. The Examiner has chosen to duplicate only specific portions of the Bonicel process. Specifically, the Examiner recognizes that the claimed invention requires a plurality of ribbons to be set by use of a single means. To remedy this deficiency, the Examiner asserts "the practitioner will realize that some parts must be duplicated while others need not be duplicated." (Answer, p. 9.) We agree with Appellants, Reply Brief page 2, that this is mere conjecture by the Examiner. The Examiner has not directed us to any teaching or suggestion in Bonicel for duplication of any portions of the disclosed method. Again, it appears the Examiner has reached this conclusion base upon impermissible hindsight derived from Appellants' own disclosure.

CONCLUSION

For the above stated reasons, we cannot sustain any of the § 103(a) rejections before us on this appeal.

REVERSED

	)	
	)	
BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	**BOARD OF PATENT**
JEFFREY T. SMITH	)	**APPEALS**
Administrative Patent Judge	)	**AND**
	)	**INTERFERENCES**
	)	
	)	
JAMES T. MOORE	)	
Administrative Patent Judge	)	

JTS/gjh

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